

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 26

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte HARRY CLENDENIN

Appeal No. 2003-0966
Application No. 09/496,486

HEARD: Nov. 5, 2003

Before FRANKFORT, STAAB, and MCQUADE, Administrative Patent Judges.
STAAB, Administrative Patent Judge.

Decision on Appeal

Harry Clendenin (appellant) originally took this appeal from the examiner's final rejection of claims 1-27, all the claims currently pending in the application. In a paper submitted October 3, 2003 (Paper No. 25), appellant "requests that claims 21-27 be withdrawn from this appeal." Accordingly, the appeal as to claims 21-27 is dismissed, leaving only the examiner's final rejection of claims 1-20 for our review.

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Appellant's invention "relates to a foot plate for mounting or suspending a tandem compressor system on a pair of channel rails" (specification, page 1). A further understanding of the invention can be derived from a reading of exemplary claim 1, the sole independent claim remaining on appeal, which is reproduced below.

As evidence of obviousness, the examiner relies upon the following reference:

Elson	5,277,554	Jan. 11, 1994
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In addition, the examiner also relies upon admitted "Prior Art" Figure 1 of the instant application.

Claims 1-20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Elson in view of admitted "Prior Art" Figure 1.

Reference is made to appellant's main and reply briefs (Paper Nos. 14 and 18) and to the examiner's answer (Paper No. 17) for the respective positions of appellant and the examiner regarding the merits of this rejection.

Discussion

With reference to appellant's Figure 2, independent claim 1 reads as follows:

1. A hermetic compressor assembly [10] comprising:
a first hermetic compressor [12] having a first shell [28];

a first foot plate [16] attached to said first shell, said first foot plate defining a first mounting plate having a length and a width;

a first upwardly extending pair of flanges [74, 76] attached to said first mounting plate and extending substantially the entire width of said first mounting plate in a first direction relative to said first mounting plate; and

a first downwardly extending pair of flanges [78, 80] attached to said first mounting plate and extending substantially the entire length of said first mounting plate in a second direction relative to said first mounting plate, said second direction being opposite to said first direction.

Elson, the examiner's primary reference, is directed to a mounting system for mounting a pair of compressors 12 and 14 in tandem. As shown in Figures 2 and 4, each compressor is provided with a mounting plate 32 having an aperture 34 at each corner for mounting the compressor on a pair of parallel rails 16. With reference to Figure 4, mounting plates 32 are supported on rails 16 by means of bolts 24 and grommets 36. Each rail has four apertures 20 which includes annular threaded sections 22 for receiving bolts 24. Rails 16 further includes apertures 26 disposed at opposite ends of the rails. Apertures 26 accommodate bolts 29 and grommets 80 for attaching the rails to a generally horizontal surface 33. Thus, each compressor is supported by bolts 24 and grommets 36 on

the rails 16, and rails 16 are in turn supported on horizontal surface 33 by bolts 29 and grommets 80.

Concerning "Prior Art" Figure 1, it is the examiner's position (answer, pages 3-4) that

"Prior Art" Figure 1 of the instant application, as well as the specification (page 2, lines 5-21) teach that a plate 112 used to mount a compressor is old and well known in the art. Further, the admitted prior art teaching cites that the mounting plate includes four downwardly turned flanges 116-122 that are used to mount a compressor with sufficient support, and that the prior art design may be reworked such that the flanges are turned in an upwards direction to provide clearance for the mounting rails.

In rejecting the appealed claims as being unpatentable over Elson in view of "Prior Art" Figure 1, the examiner considers (answer, page 3) that Elson does not teach a mounting plate with flanges.¹ The examiner concludes, however, that

[i]t would have been obvious to the ordinarily skilled artisan to rework the entire flange [of the "Prior Art"

¹Although not separately numbered in the drawings or expressly described in the specification, Figures 2 and 4 of Elson appear to show the edges of the mounting plates being provided with downwardly turned flanges extending between the apertures 34 located at the corners of the plates. In this regard, see the unnumbered downwardly extending member in Figure 4 that intersects the lead line for reference number "36" and what appears to be corresponding unnumbered elements in Figure 2 adjacent the corners of the mounting plate. In the standing rejection before us for review, the examiner does not appear to rely on this apparent disclosure in Elson of a mounting plate having downwardly extending flanges.

Figure 1 mounting plate] in a single direction, in order to reduce manufacturing costs and assembly time, while enhancing the strength of the design. Therefore, it would have been obvious to one of ordinary skill in the art to use a mounting plate having flanges, as taught by the admitted prior art, in the Elson invention, in order to advantageously provide sufficient support for the compressors, and to design the flanges in the same, upwardly-turned direction, in order to advantageously provide for ease of manufacturing and reduced manufacturing costs.

Rejections based on 35 U.S.C. § 103 must rest on a factual basis. In making such a rejection, the examiner has the initial duty of supplying the requisite factual basis and may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis. *In re GPAC, Inc.*, 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995); *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967), *cert. denied*, 389 U.S. 1057 (1968).

Appellant's specification (page 2) provides the following explanation of the relationship between "Prior Art" Figure 1 and the claimed invention:

The typical method for mounting tandem compressors is to provide a pair of parallel mounting rails 124 to which two compressors 110 and two foot plates 112 are secured. Because foot plate 112 includes four downward turned flanges 116-122, both ends of two opposed flanges 116 and 118 or 120 and 122 must be reworked or machined as shown

at 126 in Figure 1 to provide clearance for the pair of parallel mounting rails.

The present invention addresses this problem by having a foot plate with one pair of opposing flanges extending in one direction while having the other pair of opposing flanges extending in the opposite direction. This provides clearance for the parallel mounting rails while still providing sufficient support for mounting a single compressor unit on a single foot plate if desired.

In the present case, the examiner has failed to advance any factual basis whatsoever to support the conclusion stated in the answer that it would have been obvious to one of ordinary skill in the art to modify the mounting plate of "Prior Art" Figure 1 such that one pair of flanges extends upwardly along substantially the entire width of the mounting plate and the other pair of flanges extends downwardly along substantially the entire length of the mounting plate, as now claimed. The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification (see *In re Gordon*, 733 F.2d 900, 902, 221 USPQ 1125, 1127 (Fed. Cir. 1984)). Simply put, no suggestion for modifying the mounting plate of "Prior Art" Figure 1 is found in either Elson or "Prior Art" Figure 1 and the description thereof in appellant's specification.

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Accordingly, we shall not sustain the standing 35 U.S.C.
§ 103(a) rejection of claim 1, or of claims 2-20 that depend
therefrom, as being unpatentable over Elson in view of "Prior Art"
Figure 1.

The decision of the examiner is reversed.

REVERSED

CHARLES E. FRANKFORT)	
Administrative Patent Judge)	
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)	BOARD OF PATENT
LAWRENCE J. STAAB)	APPEALS
Administrative Patent Judge)	AND
)	INTERFERENCES
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JOHN P. MCQUADE)	
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